



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/534,233	03/24/2000	Khai Hee Kwan		3307

23336 7590 09/12/2005

KHAI HEE KWAN
315 AVOCA ST.
RANDWICK, 02031
AUSTRALIA

EXAMINER

GRAHAM, CLEMENT B

ART UNIT	PAPER NUMBER
----------	--------------

3628

DATE MAILED: 09/12/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/534,233

Applicant(s)

KWAN, KHAI HEE

Examiner

Clement B. Graham

Art Unit

3628

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 June 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 15-19 and 24-38 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 15-19 and 24-38 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Claims 15-19, and 24-38, remained pending.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 15-19 and 24-38, are rejected under 35 U.S.C. 103(a) as being unpatentable over Huberman U.S. Patent No. 5, 826, 244 in view Breen Jr, et al (Hereinafter Breen Jr U.S Patent 6, 598, 027).

As per claims 15, 18-19, Huberman discloses a method for soliciting competitive terms of deposit operating on a deposit auction system, said system including a programmed computer connected to a network accessible by a plurality of users within a first selected period of time and anonymity means for concealing the identities of deposit applicants ("i. e, customers and suppliers submitting services request and bids to broker" interpretive as concealing the identities" see column 3 lines 40-58"), the method executable at said computer comprising:

- a) receiving deposit application. ("i. e, request ") from a prospective depositor who is a respective one of the users, wherein said application comprising permissible personal information and money, securities or financial equivalent deposit offer terms as subscribed by the prospective depositor (see column 3 line 65 and column 4 line 5-15)
- c) receiving from at least one deposit-taking institution, who is a respective one of the users communicating over the network, at least a respective one of the responsive bids ("i. e, broker") for said deposit application wherein said bid comprises at least one of responsive deposit terms, type of guarantees, payment schedule, deposit rate, securities in exchange and terms of exchange.(see column 3 lines 45-65 and column 4 lines 5-65) and (column 19 lines 45-60 and column 20 lines 5-10) and

Art Unit: 3628

d) receiving an electronic instruction from the deposit applicant, notifying and authorizing at least one selected deposit-taking institution to access a real identity and personal information of said applicant for a second selected period of time.(see column 5 lines 10-30).

Huberman fail to explicitly teach assigning a handle to conceal to broker a real identity of the said prospective depositor and displaying said depositor's application anonymously.

However Breen, Jr discloses a potential buyer/seller wishing to become a member is also required to enter into a contractual agreement with the intermediary and to become bound by various terms, conditions and policies set forth by the intermediary (Block). Such a user agreement may include terms, conditions and policies relating to liability, product quality, taxes, shipping, payment, shilling, privacy, anonymity of buyers/sellers, and so forth. (see column 9 lines 58-65 and column 14 lines 12-23).

Therefore it would have been obvious to one of ordinary skill in the art the time the invention was made to modify the teachings of Huberman to include assigning a handle to conceal to broker a real identity of the said prospective depositor and displaying said depositor's application anonymously.

taught by Breen, Jr in order to facilitate transactions between buyers and sellers without identifying the parties involves in the transaction.

As per claim 16, Huberman discloses further comprising a step of receiving from deposit applicant communicating over the network, an electronic instruction selecting at least one of responsive deposit-taking institutions bided for said depositor's application. (see column 3 lines 45-65 and column 4 lines 5-65) and (column 19 lines 45-60 and column 20 lines 5-10).

As per claim 17, Huberman discloses the method according to claim 15, includes a step of verifying the ownership.("i. e, authentication") of said money, securities or financial equivalent as subscribed by deposit applicant.(see column 1 lines 15-20 and column 3 lines 40-55).

As per claim 24, Huberman discloses a deposit auction system including a computer connected to a network programmed to perform the method of Claim 15.(see column 20 lines 20-30).

As per claim 25, Huberman discloses a deposit auction system including a computer connected to a network programmed to perform the method of Claim 16. (see column 20 lines 20-30) and (see column 3 lines 45-65 and column 4 lines 5-65) and (column 19 lines 45-60 and column 20 lines 5-10).

As per claim 26, Huberman discloses a deposit auction system including a computer connected to a network programmed to perform the method of Claim 17. (see column 20 lines 20-30).

As per claim 27, Huberman discloses a deposit auction system including a computer connected to a network programmed to perform the method of Claim 18. (see column 20 lines 20-30 and column 1lines 15-20).

As per claim 28, Huberman discloses a deposit auction system including a computer connected to a network programmed to perform the method of Claim 19. (see column 20 lines 20-30).

As per claim 29, Huberman discloses Computer executable software code stored on a computer readable storage medium implementing the method of claim 15.(see column 1lines 15-20 and column 3 lines 45-55).

As per claim 30, Huberman discloses computer executable software code stored on a computer readable storage medium implementing the method of claim 16. (see column 3 lines 45-65 and column 4 lines 5-65) and (column 19 lines 45-60 and column 20 lines 5-10).

As per claim 31, Huberman discloses computer executable software code stored on a computer readable storage medium implementing the method of claim 17. .(see column 1 lines 15-20 and column 3 lines 40-55).

As per claim 32, Huberman discloses computer executable software code stored on a computer readable storage medium implementing the method of claim 18. .(see column 1 lines 15-20 and column 3 lines 40-55).

As per claim 33, Huberman discloses computer executable software code stored on a computer readable storage medium implementing the method of claim 19.(see column 3 lines 55).

As per claims 34-35, 37-38, Huberman discloses a deposit auction system for soliciting competitive terms of deposit connected to a network, said network comprising at least one client computer and a programmed computer further comprising a database of deposit applications said network accessible by a plurality of users within a first selected period of time. ("i. e, as interpretive see column 3 lines 40-58"), comprising:
a) means for receiving a deposit application.("i. e, request") from a prospective depositor who is a respective one of the users, wherein said application comprising permissible personal information and money, securities or financial equivalent deposit offer terms as subscribed by the prospective depositor. (see column 3 line 65 and column 4 line 5-15)

c) means for receiving from at least one deposit-taking institution, who is a respective one of the users communicating over the network, at least a respective one of the responsive bids for said deposit application offer wherein said bid comprises at least one of responsive depositing terms (see column 3 line 65 and column 4 line 5-15) type of guarantees, payment schedule, deposit rate, securities in exchange and terms of exchange. (see column 3 lines 45-65 and column 4 lines 5-65) and (column 19 lines 45-60 and column 20 lines 5-10) and

d) means for receiving an electronic instruction from the deposit applicant, notifying and authorizing at least one selected deposit-taking institution to access a real identity and personal information of said applicant for a second selected period of time.(see column 5 lines 10-30).

Huberman fail to explicitly teach anonymity means for assigning a handle to conceal a real identity of the said prospective depositor for and displaying said depositor's application anonymously.

However Breen, Jr discloses A potential buyer/seller wishing to become a member is also required to enter into a contractual agreement with the intermediary and to become bound by various terms, conditions and policies set forth by the intermediary

Art Unit: 3628

(Block). Such a user agreement may include terms, conditions and policies relating to liability, product quality, taxes, shipping, payment, shilling, privacy, anonymity of buyers/sellers, and so forth. (see column 9 lines 58-65 and column 14 lines 12-23).

Therefore it would have been obvious to one of ordinary skill in the art the time the invention was made to modify the teachings of Huberman to include anonymity means for assigning a handle to conceal a real identity of the said prospective depositor for and displaying said depositor's application anonymously taught by Breen, Jr in order to facilitate transactions between buyers and sellers without identifying the parties involves in the transaction.

As per claim 36, Huberman fails to explicitly teach means for verifying the ownership of said money, securities or financial equivalent as subscribed by deposit applicant.

However verifying the ownership and authenticity of a document is old and well known in the art because the document would have had to consist of an identification number name of the owner and date acquired.

Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the teachings of Huberman to include verifying the ownership and authenticity of a document because the document would have had to consist of an identification number name of the owner and date acquired.

Conclusion

RESPONSE TO Arguments

4. Applicant 's arguments filed on 6/05/2005 are has been fully considered but they are not eresussive for the following reasons.

5. In response to Applicant's arguments as it pertains to Huberman and Been.

6. In response to Applicant's arguments that Huberman and Been fail to teach or suggest" method for soliciting competitive terms of deposit operating on a deposit auction system, said system including a programmed computer connected to a network accessible by a plurality of users within a first selected period of time and anonymity means for concealing the identities of deposit applicants the method executable at said a) receiving deposit application from a prospective depositor who is a respective one of

Art Unit: 3628

the users, wherein said application comprising permissible personal information and money, securities or financial equivalent deposit offer terms as subscribed by the prospective depositor c) receiving from at least one deposit-taking institution, who is a respective one of the users communicating over the network, at least a respective one of the responsive bids for said deposit application wherein said bid comprises at least one of responsive deposit terms, type of guarantees, payment schedule, deposit rate, securities in exchange and terms of exchange and (d) receiving an electronic instruction from the deposit applicant, notifying and authorizing at least one selected deposit-taking institution to access a real identity and personal information of said applicant for a second selected period of time these limitation were addressed in a combination of teachings as stated, Huberman discloses receiving deposit application. ("i. e, request ") from a prospective depositor who is a respective one of the users, wherein said application comprising permissible personal information and money, securities or financial equivalent deposit offer terms as subscribed by the prospective depositor see column 3 line 55-65 and column 4 line 5-15, c) receiving from at least one deposit-taking institution, who is a respective one of the users communicating over the network, at least a respective one of the responsive bids ("i. e, broker") for said deposit application wherein said bid comprises at least one of responsive deposit terms, type of guarantees, payment schedule, deposit rate, securities in exchange and terms of exchange see column 3 lines 45-65 and column 4 lines 5-65 and column 19 lines 45-60 and column 20 lines 5-10 and d) receiving an electronic instruction from the deposit applicant, notifying and authorizing at least one selected deposit-taking institution to access a real identity and personal information of said applicant for a second selected period of time see column 5 lines 10-30 and deposit of receiving from deposit applicant communicating over the network, an electronic instruction selecting at least one of responsive deposit-taking institutions bided for said depositor's application see column 3 lines 45-65 and column 4 lines 5-65) and column 19 lines 45-60 and column 20 lines 5-10 and a step of verifying the ownership. ("i. e, authentication") of said money, securities or financial equivalent as subscribed by deposit applicant see column 1 lines 15-20 and column 3 lines 40-55 and a deposit auction system including a computer connected to a

Art Unit: 3628

network programmed to perform the method of Claim 15 and see column 20 lines 20-30 and a computer executable software code stored on a computer readable storage medium implementing the method see column 1 lines 15-20 and column 3 lines 45-55 and computer executable software code stored on a computer readable storage medium implementing the method see column 3 lines 45-65 and column 4 lines 5-65 and column 19 lines 45-60 and column 20 lines 5-10.

Breen, Jr discloses a potential buyer/seller wishing to become a member is also required to enter into a contractual agreement with the intermediary and to become bound by various terms, conditions and policies set forth by the intermediary (Block). Such a user agreement may include terms, conditions and policies relating to liability, product quality, taxes, shipping, payment, shilling, privacy, anonymity of buyers/sellers, and so forth. see column 9 lines 58-65 and column 14 lines 12-23.

Therefore it is obviously clear that the claimed limitations were addressed above within the combine teachings of Huberman and Breen Jr.

7. Applicant also maintains that Huberman and Breen Jr cannot be combined, the Examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).

The rationale to modify or combine the prior art does not have to be expressly stated in the prior art; the rationale may be expressly or impliedly contained in the prior art or it may be reasoned from knowledge generally available to one of ordinary skill in the art, established scientific principles, or legal precedent established by prior case law. In *re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988); *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). See also *In re Eli Lilly & Co.*, 902 F.2d 943, 14 USPQ2d 1741 (Fed. Cir. 1990) (discussion of reliance on legal precedent); *In re Nilssen*, 851 F.2d 1401, 7 USPQ2d 1500 (Fed. Cir. 1988) (references do not have to explicitly

Art Unit: 3628

suggest combining teachings); Ex parte Clapp, 227 USPQ 972 (Bd. Pat. App & Inter); and Es parte

Levengood, 28 USPQ2d 1300 (Bd. Pat. App. & Inter. 1993) (reliance on logic and sound scientific reasoning).

Also in reference to Ex parte Levengood, 28 USPQ2d, 1301, the court stated that "Obviousness is a legal conclusion, the determination of which is a question of patent law. Motivation for combining the teachings of the various references need not to explicitly found in the reference themselves, In re Keller, 642 F.2d 413, 208USPQ 871 (CCPA 1981). Indeed, the Examiner may provide an explanation based on logic and sound scientific reasoning that will support a holding of obviousness. In re Soli, 317 F.2d 941 137 USPQ 797 (CCPA 1963)."

8. In response to applicant arguments against the references individually, one cannot show nonobviousness by attacking the reference individually where the rejections are based on a combination of references. See In Keller, 642 F.2d, 208 USPQ 871 (CCPA 1981); In re Merk & Co., 800 F.2d 1091, 231 USPTQ 375 (Fed. Cir. 1986).

9. With respect to Applicant's second argument, Examiner respectfully submits that obviousness is not determined on the basis of the evidence as a whole and the relative persuasiveness of the arguments. See In re Oetiker, 977F. 2d 1443, 1445,24 USPQ2d 1443, 1444 (Fed. Cir. 1992); In re Hedges, 783F.2d 1038, 1039, 228 USPQ* 685, 686 (Fed. Cir.1992); In re Piaseckii, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir.1984); In re Rinehart, 531 F.2d 1048, 1052, 189 USPQ 143, 147 (CCPA 1976). Using this standard, the Examiner respectfully submits that he has at least satisfied the burden of presenting a prima facie case of obviousness, since he has presented evidence of corresponding claim elements in the prior art and has expressly articulated the combinations and the motivations for combinations that fairly suggest Applicant's claimed invention (See paper number 10). Note, for example, in the instant case, the Examiner respectfully notes that each and every motivation to combine the applied references are accompanied by select portions of the respective reference(s) which specially support that particular motivation and /or an explanation based on the

Art Unit: 3628

logic and scientific reasoning of one ordinarily skilled in the art at the time of the invention that support a holding of obviousness. As such, it is not seen that the Examiner's combination of references is unsupported by the applied prior art of record. Rather, it is respectfully submitted that explanation based on the logic and scientific reasoning of one of ordinarily skilled in the art at the time of the invention that support a holding of obviousness has been adequately provided by the motivations and reasons indicated by the Examiner, Ex pane Levengood, 28 USPQ2d 1300(Bd. Pat. App &.,4/293 Therefore the combination of reference is proper and the rejection is maintained.

10. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.


11. Any inquiry concerning this communication or earlier communication from the Examiner

should be directed to Clement Graham whose telephone number is (703) 305-1874 Or Hyung S. Sough whose telephone number is (703) 308-0505. The examiner can normally be reached on Monday through Friday from 8:30 AM to 5:00 PM. The fax phone number for this Art Unit is (703) 305-0040.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 305-3900.

CG

August 24, 2005.


FRANTZY POINVIL
PRIMARY EXAMINER
All 3628